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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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| First Named Applicant: Bolle |) | Art Unit: 2625 |
| |) | |
| Serial No.: 09/943,896 |) | Examiner: Cuoso |
| |) | |
| Filed: August 31, 2001 |) | YOR20000609US2 |
| |) | |
| For: SYSTEM AND METHOD FOR FINGERPRINT |) | January 23, 2006 |
| IMAGE ENHANCEMENT USING PARTITIONED |) | 750 B STREET, Suite 3120 |
| LEAST-SQUARED FILTERS |) | San Diego, CA 92101 |
| |) | |

RESPONSE TO OFFICE ACTIONCommissioner for Patents
Alexandria, VA

Dear Sir:

The allowance of Claims 1-8 and 11-24 and indicated allowability of Claim 39 in the Office Action dated December 13, 2005 is gratefully acknowledged. The sole remaining issue is the rejection of Claim 38 under 35 U.S.C. §103 as being unpatentable over Clarke et al., USPN 5,825,936 (directed to identifying suspect regions of breast X-rays) in view of Chang et al., USPN 5,572,597.

Applicant believes there are three errors in the rejection, the first being the incorrect allegation that Clarke et al., col. 6, lines 20-59 teaches filters derived from expert-developed ground truth pairs. While Applicant is mindful that claims are to be broadly construed during prosecution, that does not mean that they may be so broadly construed as to remove them from meanings that the skilled artisan would ascribe to them, MPEP §2111.01. The relied-upon section of Clarke et al. teaches that in practice, since $f(i,j)$ is not available, the [ensemble mean] is derived from the degraded observation $g(i,f)$ to derive the filter expressed in equation

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14, col. 6, lines 32-43. Thus, the filter is derived using the "degraded observation $g(i,f)$ ", which apparently is the original or true mammogram image (" f ") as corrupted by noise (" n "), see equation (1) of Clarke et al.

With this in mind, it is clear that for the allegation in the rejection to be legitimate, it must be shown or explained why the skilled artisan regards using a degraded image to develop a filter as being the same thing as using expert-developed ground truth pairs to learn a set of partitioned least-squares filters. As Applicant is confident the examiner will understand, absent evidence of record that skilled artisans regard degraded images as being the same thing as expert-derived pairs, particularly in light of the fact that the reference itself never even uses the word "expert", the rejection cannot be acquiesced in.

Second, the proffered rationale for using the mammogram analysis invention of Clarke et al. for fingerprints as taught in Chang et al. amounts to nothing more than observing that despite being from disparate fields, the two use "similar" approaches in that they both use sub-regions of images in their respective analyses. However, Clarke et al. never mentions fingerprints, or that its invention is suitable for use in fingerprint analysis. In fact, Clarke et al., col. 13, lines 18-25 seems to make clear that its method is peculiar to mammograms. No teaching in Chang et al. has been identified to the effect that Chang et al. suggests that "my method is good but it is interchangeable with other image classification methods", much less that one might look to the mammogram art to find them. In other words, while the examiner alleges an equivalence between the methods of Clark and Chang, no support exists in the prior art to support the allegation.

Applicant would further like to point out that Clark is not analogous either to Chang or to the present invention, in that no showing has been made, supported by evidence of record, that analysts of fingerprints

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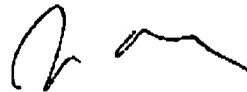
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routinely or logically look to the mammogram analysis art. Accordingly, under MPEP §2141.01(a), the proposed combination of references is improper.

The Examiner is cordially invited to telephone the undersigned at (619) 338-8075 for any reason which would advance the instant application to allowance.

Respectfully submitted,



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